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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/582,823	06/14/2006	Kenneth L. Arrington	21439YP	7413				
210 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907	7590 10/01/2009		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>TRUONG, TAMTHOM NGO</td></tr></table>		EXAMINER	TRUONG, TAMTHOM NGO		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/582,823

Applicant(s)

ARRINGTON ET AL.

Examiner

TAMTHOM N. TRUONG

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/14/06 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 11, 21-24, 29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8, 10, 11, 21-24, 29 and 31-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Lack of Unity

Applicant's preliminary amendment of 6-14-06 is acknowledged. Claims 1-8, 10, 11, 21-24, 29 and 31-34 are pending. Claims 9, 12-20, 25-28 and 30 are cancelled.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I: claim(s) 1, 2, 6, 8, 10 and 11 (in part), drawn to compounds of Formula (I), and pharmaceutical composition thereof, wherein W represents N. Further election of species and/or restriction will be required if this group is elected.

Group II: claim(s) 1, 2, 6, 8, 10 and 11 (in part), drawn to compounds of Formula (I), and pharmaceutical composition thereof, wherein X represents N. Further election of species and/or restriction will be required if this group is elected.

Group III: claim(s) 1, 2, 6, 8, 10 and 11 (in part), drawn to compounds of Formula (I), and pharmaceutical composition thereof, wherein Y represents N. Further election of species and/or restriction will be required if this group is elected.

Group IV: claim(s) 1, 2, 5, 6, 8, 10 and 11 (in part), drawn to compounds of Formula (I), and pharmaceutical composition thereof, wherein Z represents N. Further election of species and/or restriction will be required if this group is elected.

Group V: claim(s) 1-8, 10 and 11 (in part), drawn to compounds of Formula (I), and pharmaceutical composition thereof, wherein W, X, Y and Z all represent CH, CH₂ (**quinazoline core**). Further election of species and/or restriction will be required if this group is elected.

Group VI: claims 21-24, 29 and 31-34 (in part), drawn to a method of treating or preventing cancer comprising administering an effective amount of a compound of formula I in combination with another chemotherapeutic agent or radiation therapy. Further election of species and/or restriction will be required if this group is elected.

The inventions of Groups I - V share a common technical feature of a **fused pyrimidinyl** ring, which does not sufficiently define the invention, and is not a contribution to the art. It is the combination of variables W, X, Y and Z that defines the ring which in turn giving compounds of each group their unique physical, chemical properties and biological activities. Depending on what they represent, the claimed formula would have different structure. Thus, a reference anticipated or rendered obvious compounds of one group would not do so to those of other groups. Therefore, a separate search is required for each group.

The invention of Group VI is drawn to a method of treating or preventing cancer which relates to the other groups (I-V) as a combination-subcombination, and requires additional search and examination beyond the scope of the claimed compound. A reference reading on the compounds would not necessarily read on the claimed method. Therefore, the search and examination for all 6 groups would impose a serious burden on the examiner in charge of this invention. Note, a preliminary search in EAST yields a total of 31,898 hits which clearly shows an overwhelming number of references for consideration.

Rejoinder Criteria: The examiner has required restriction between product and method claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Method claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is

presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined method claims will be withdrawn, and the rejoined method claims **will be fully examined for patentability in accordance with 37 CFR 1.104**. Thus, to be allowable, **the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112**. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and method claims may be maintained. Withdrawn method claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the method claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMTHOM N. TRUONG whose telephone number is (571)272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tamthom N. Truong/
Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624

9-28-09